

# GEOGRAPHICAL INDICATIONS BILL, 2013

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## **GEOGRAPHICAL INDICATIONS BILL, 2013**

### **A BILL FOR AN ACT TO PROVIDE FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND RELATED MATTERS.**

**Enacted by the Parliament of The Bahamas**

#### **PART I—PRELIMINARY**

##### **1. Short title and commencement.**

- (1) This Act may be cited as the the Geographical Indications Act, 2013.
- (2) This Act shall come into operation on such day as the Minister may, by notice published in the Gazette, appoint.

##### **2. Interpretation.**

In this Act —

“**Court**” means the Supreme Court;

“**geographical indication**” means an indication that identifies goods as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“**Intellectual Property Office**” means the Intellectual Property Office referred to in section 3 of the Patents Act;

“**producer**” means —

- (a) any producer of agricultural products or any other person using natural products for the production of other goods;
- (b) any industry or manufacturer of products or handicraft; or
- (c) any trader dealing in the products mentioned in paragraphs (a) and (b);

“**Register**” means the Register of Geographical Indications;

“**Registrar**” means the Registrar of the Intellectual Property Office and any reference to the Registrar shall be construed as including a reference to any officer discharging the functions of the Registrar.

## **PART II—PROTECTION OF GEOGRAPHICAL INDICATIONS**

### **3. Application of Act.**

- (1) Protection under this Act is accorded to geographical indications whether or not they are registered.
- (2) Notwithstanding subsection (1), geographical indications which although literally true as to the territory, region or locality in which the goods originate, falsely represent to the public that the goods originate in another territory, are not protected by this Act.
- (3) For the purposes of this section, registration of a geographical indication under Part III raises the presumption that the geographical indication is a geographical indication within the meaning of section 2.

### **4. Homonymous geographical indications for wines.**

- (1) Subject to section 3(2), in the case of homonymous geographical indications for wines, protection shall be accorded to each indication.
- (2) The Registrar shall, in cases of permitted concurrent use of homonymous geographical indications, determine the practical conditions under which such indications will be differentiated from each other.
- (3) For the purposes of subsection (2), the Registrar shall have regard to the need —
  - (a) to ensure equitable treatment of the producers concerned; and
  - (b) to ensure that consumers are not misled.
- (4) For the purposes of the section, “**homonymous**” means a term using the same name for different things.

### **5. Exclusion from protection.**

The following shall not be registered as geographical indications —

- (a) indications that do not correspond to the definition of “geographical indication” in section 2;
- (b) indications that offend public order or morality;

- (c) geographical indications that are not or cease to be protected in their country of origin, or that have fallen into disuse in that country.

## **6. Prohibition against improper use of geographical indication.**

- (1) No person shall —
  - (a) in the designation or presentation of goods, by any means, indicate or suggest that the goods originate in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the goods;
  - (b) use a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like;
  - (c) engage in conduct which constitutes an act of unfair competition, being an act of competition contrary to honest practices in industrial or commercial matters and including —
    - (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor,
    - (ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor,
    - (iii) indications or allegations, the use of which in the course of trade, is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.
- (2) A person who contravenes subsection (1) is guilty of an offence and shall be liable on summary conviction to a fine of ten thousand dollars or to imprisonment for two years or to both such fine and imprisonment.

## **7. Civil remedies.**

- (1) Any interested person may institute proceedings in the Court to prevent, in respect of geographical indications, any act referred to in subsection (1) of section 6.
- (2) The Court may, in proceedings under subsection (1), in addition to granting an injunction, award damages and grant any other remedy or relief the Court thinks fit.

## PART III—REGISTRATION OF GEOGRAPHICAL INDICATIONS

### 8. Application for registration.

- (1) The following may make an application to the Registrar for the registration of a geographical indication —
  - (a) persons carrying on or proposing to carry on any activity as producers in the geographical area specified in the application, with respect to the goods specified in the application;
  - (b) consumers and groups of consumers; or
  - (c) any marketing organisation incorporated or registered under the Companies Act (*Ch. 308*) or established under any Act.
- (2) Where an applicant's ordinary residence or principal place of business is outside The Bahamas, he shall be represented by a counsel and attorney who is resident and practising as a counsel and attorney in The Bahamas.
- (3) An application for the registration of a geographical indication shall specify —
  - (a) the name, address and nationality of the person making the application and the capacity in which the applicant is applying for registration;
  - (b) the geographical indication for which registration is sought;
  - (c) the geographical areas to which the geographical indication applies;
  - (d) the goods to which the geographical indication applies;
  - (e) the quality, reputation or other characteristic of the goods in respect of which the geographical indication is used;

and shall be accompanied by a specification describing in sufficient detail the specific characteristics of the goods for which the geographical indication is used, the area and method of production of the goods, the link between the characteristics of the goods and the area and method of production, the manner in which the specified characteristics are controlled and other prescribed particulars, and the prescribed fee.

- (4) The application shall indicate the manner in which the continued compliance of the conditions laid down in the specification will be controlled by an independent body or authority.

### 9. Examination and publication of application.

- (1) The Registrar shall examine every application to ascertain whether it complies with the requirements of Part II of this Act and the regulations.

- (2) Where the Registrar is satisfied that the application complies with the requirements of Part II of this Act and that the regulations referred to in subsection (1) are fulfilled, he shall cause the application to be published in the prescribed manner.
- (3) Where the Registrar is not satisfied that the application complies with the requirements of Part II of this Act or that the regulations referred to in subsection (1) are fulfilled, he shall notify the applicant of his objections and give the applicant an opportunity to amend the application.

#### **10. Objection to registration.**

- (1) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of an objection to the registration of the geographical indication referred to in section 8 on the grounds that it does not comply with the requirements of Part II of this Act or the regulations.
- (2) The Registrar shall send a copy of the notice referred to in subsection (1) to the applicant.
- (3) Upon receipt of the copy of the notice referred to in subsection (2), the applicant shall, within the prescribed period and in the prescribed manner, send to the Registrar a counter-statement of the grounds on which the applicant relies for his application; and if he does not do so, he shall be deemed to have abandoned the application.
- (4) Where the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the objector and, after hearing the parties, if either or both wish to be heard and considering the merits of the case, the Registrar shall decide whether the geographical indication should be registered.

#### **11. Registration.**

- (1) Where the Registrar is satisfied that the requirements referred to in section 8 have been complied with and either —
  - (a) there has been no objection to the registration of the geographical indication within the prescribed period; or
  - (b) there has been an objection to the registration of the geographical indication and the objection has been decided in the applicant's favour,the Registrar shall register the geographical indication, issue to the applicant a certificate of registration and publish a notice of the registration.
- (2) Where, as the result of an objection made under this section or for any other reason, the Registrar is satisfied that the application for registration

of a geographical indication does not comply with the requirements of sections 5 or 8 or the regulations the Registrar shall refuse the application.

## **12. Right of use.**

Only producers of products possessing the quality, reputation or other characteristic specified in the Register and who are carrying on their activity in the geographical area specified in the Register may use a registered geographical indication, in the course of trade, with respect to such products.

## **13. Register.**

- (1) The Registrar shall maintain a Register in which he shall record all matters required by this Act to be recorded.
- (2) The Register shall be open for inspection by the public during normal working hours, and any person may obtain extracts therefrom or make copies of such extracts in the manner and under the conditions prescribed.

## **14. Cancellation and rectification of registration.**

- (1) Any interested person may apply to the Registrar for —
  - (a) the cancellation of the registration of a geographical indication on the grounds that it does not comply with section 5; or
  - (b) the rectification of the registration of a geographical indication on the grounds —
    - (i) that the geographical area specified in the registration does not correspond to the geographical indication, or
    - (ii) that the indication of the products in respect of which the geographical indication is intended to apply or the indication of the quality, reputation or other characteristic of such products is missing or is unsatisfactory.
- (2) In any proceedings under this section, notice of the request for cancellation or rectification—
  - (a) shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and
  - (b) shall, by a publication in the prescribed manner, be given to all persons having the right to use the geographical indication under section 12.
- (3) The persons referred to in subsection (2) and any other interested person may, within such period as the Court specifies in the notice and publication referred to in that subsection, apply to be joined in the proceedings.



- (4) The Registrar of the Supreme Court shall notify the Registrar of the decision of the Court or the decision on any appeal therefrom and the Registrar shall record it and publish a notice of the decision as soon as possible.

**15. Correction of errors.**

The Registrar may, upon notice to the applicant, subject to the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any matter recorded pursuant to this Act or the regulations.

**16. Extension of time.**

Where the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceedings under this Act or the regulations, upon notice to the parties concerned and upon such terms as he may direct notwithstanding that the time for doing the Act or taking the proceedings has expired.

**17. Discretionary powers.**

The Registrar shall, before exercising any discretionary power vested in him by this Act in a manner that is likely to adversely affect any party to proceedings before him, give that party an opportunity to be heard.

**18. Publication.**

The Registrar shall publish in the Gazette and in a newspaper published daily in The Bahamas everything required to be published under this Act.

**19. Jurisdiction of Court.**

- (1) The Court has jurisdiction in cases of disputes relating to the application of this Act and in matters which, under this Act, are to be referred to the Court.
- (2) Any party aggrieved by a decision of the Registrar may, within two months after the date of the decision, appeal against the decision to a Judge in Chambers.

## **PART IV—EXCEPTIONS TO PROVISIONS CONCERNING MARKS**

### **20. Misleading marks.**

The Registrar shall, on his own motion or at the request of an interested party, refuse or invalidate the registration of a trademark that contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in The Bahamas is of such a nature as to mislead the public as to the true place of origin.

### **21. Marks conflicting with a geographical indication for wines and spirits.**

The registration of —

- (a) a trademark for wines that contains or consists of a geographical indication identifying wines; or
- (b) a trademark for spirits that contains or consists of a geographical indication identifying spirits,

shall be refused or invalidated by the Registrar on his own motion or at the request of an interested party, with respect to such wines or spirits that do not originate in the territory indicated.

### **22. Exceptions regarding prior users.**

- (1) Nothing in this Act shall prevent continued and similar use in The Bahamas, of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by citizens or permanent residents of The Bahamas, who have used that geographical indication in a continuous manner with regard to the same or related goods or services in The Bahamas for a period of at least ten years immediately preceding the commencement of this Act.
- (2) Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith —
  - (a) before the commencement of this Act; or
  - (b) before the geographical indication is protected in its country of origin,

this Act shall not prejudice the registrability of or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

- (3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customarily used in common language as the common name for such goods or services in The Bahamas.
- (4) Any request for relief made under Part II in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected geographical indication has become generally known in The Bahamas or after the date of registration of the trademark in The Bahamas.
- (5) Subsection (4) applies only where that trademark has been published by the date of registration of the trademark in The Bahamas, where that date is earlier than the date on which the adverse use became generally known in The Bahamas and provided that the geographical indication is not used or registered in bad faith.
- (6) This Act shall not affect the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in a manner that is likely to mislead the public.

## **PART V—MISCELLANEOUS**

### **23. Representation.**

- (1) An applicant whose residence or principal place of business is outside The Bahamas shall be represented by a counsel and attorney.
- (2) For the purposes of this Act, “**counsel and attorney**” has the meaning assigned to it by section 2 of the Legal Profession Act, (Ch. 64).

### **24. Regulations.**

The Minister may make regulations —

- (a) prescribing anything that is required by this Act to be prescribed; or
- (b) that are necessary for giving effect to this Act.

## OBJECTS AND REASONS

This Bill seeks to provide for the protection of geographical indications in order to meet the standards set by the World Trade Organisation on trade related aspects of intellectual property rights.

Part I deals with preliminary matters. Of note is the definition of “geographical indication”. It means an indication that identifies goods as originating in a territory where the quality, reputation or other characteristic of the goods is attributable to its geographical origin.

Part II deals with the protection of geographical indications. Protection is given to a geographical indication whether or not it is registered. Protection will not be given to an indication that offends public order or morality or which has ceased to be protected in the country of origin.

It is an offence in the designation or presentation of goods to indicate or suggest that the goods originate in a geographical area other than the true place of origin; to use a geographical indication identifying wines or spirits for wines or spirits not originating in the place indicated by the geographical indication; or to engage in conduct which constitutes an act of unfair competition being an act of competition contrary to honest practices in industrial or commercial matters. The penalty for an offence is a fine of \$10,000 or imprisonment for 2 years.

Part III deals with the registration of geographical indications. Application for the registration of a geographical indication must be made to the Registrar General and may be made by persons carrying on an activity as producers of goods in a geographical area, consumers or marketing organisations incorporated or registered under the Companies Act (*Ch. 308*).

Where an applicant’s ordinary residence or principal place of business is outside The Bahamas he must be represented by counsel and attorney.

Subclause (3) of clause 8 sets out the matters which must be included in the application.

The Registrar will examine the application and if satisfied, he will publish the application inviting any objections to the application. If any objection is received the Registrar will forward the objection to the applicant for comments. The Registrar will give a hearing to the parties and then decide whether or not to register the geographical indication.

If the Registrar registers the geographical indication he will issue to the applicant a certificate of registration and publish in the Gazette and in a daily newspaper notice of the registration.

Any interested person may apply to the Supreme Court for cancellation of the registration or for the rectification of the registration.

Part IV deals with exceptions to provisions concerning trademarks.

The Registrar on his own motion or at the request of any interested party may refuse or invalidate the registration of a trademark that contains a geographical indication with respect to goods not originating in the territory indicated if use of the indication in the trademark for the goods is of a nature to mislead the public as to the true place of origin.

Persons may continue use of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by citizens or permanent residents of The Bahamas who have used that geographical indication in a continuous manner with regard to the same goods or services in The Bahamas for a period of at least 15 years before the Act comes into force or in good faith prior to that date.

Part V deals with miscellaneous matters. Clause 24 gives the Minister power to make regulations for giving effect to the Act.